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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD PAUL DEAN,
KRISTINA LYNN MANN, and
SEAN WILLIAM TUCKER

Appeal 2008-0213
Application 10/655,443
Technology Center 3600

Decided: March 14, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Dean, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

The claimed invention is directed to a bracket system for mounting a device bracket with an assembly. (Spec. ¶ 0008.)

Claims 1, 9, and 12, reproduced below, are representative of the subject matter on appeal.

1. A bracket system comprising:
 - a plurality of chassis brackets attached to a chassis base;
 - a mounting bracket assembly with a plurality of tapered mounting bracket assembly slots; and
 - a plurality of tabs on said chassis base, said plurality of tabs for engaging with said plurality of tapered mounting bracket assembly slots.
9. The bracket system of claim 1 wherein at least one of said chassis brackets supports two devices.
12. A bracket system for securing a subassembly to a chassis comprising:

¹ Our decision will make reference to Appellants' Appeal Brief ("App. Br.," filed Jul. 20, 2005), Reply Brief ("Reply Br.," filed Dec. 02, 2005), and the Examiner's Answer ("Answer," mailed Oct. 04, 2005 and remailed Apr. 07, 2006).

means for vertical alignment of the subassembly, said vertical alignment means also providing means for positive stop for said subassembly;

means for horizontal alignment of said subassembly, said horizontal alignment means also providing means for positive stop for said subassembly; and

means for securing said subassembly to said chassis, said means for securing including a rotatable handle means.

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Yoshida	US 4,947,661	Aug. 14, 1990
Gonzalez	US 5,564,804	Oct. 15, 1996
Francovich	US 5,828,547	Oct. 27, 1998
Ho	US 5,940,265	Aug. 17, 1999
Dean	US 6,616,106 B1	Sep. 09, 2003

THE REJECTIONS

The following rejections are before us for review:

Claims 1-11 and 15-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Dean (U.S. Patent No. 6,616,106 B1).

Claims 1, 3, 4, 6, 8, 10, 15, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez in view of Ho.

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez in view of Ho and in further view of Francovich.

Claims 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez et al. in view of Yoshida.

ISSUES²

The first issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1-11 and 15-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Dean.

The second issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 3, 4, 6, 8, 10, 15, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez and Ho.

The third issue is whether the Appellants have shown that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez, Ho, and Francovich.

The fourth issue is whether the Appellants have shown that the Examiner erred in rejecting claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez and Yoshida.

² Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Gonzalez discloses a disk drive bracket. This bracket fits within a computer housing having a housing base 102, four housing walls, and a housing cover. (Gonzalez, col. 3, ll. 9-12 and Figure 1.) As shown within Figure 1, two disk drive brackets are within the housing and two housing walls are identified as 104 and 106.
2. The bracket has a base 201 that includes an outer portion 202 and a recessed portion 204. The recessed portion 204 contacts the housing base 102. (Gonzalez, col. 3, ll. 17-20.)
3. The bracket 108 has a base opening (slot) 216. The housing base has a housing tab 402 that fits securely within slot 216 and thus preventing the bracket from moving in a plane perpendicular to the plane in which the outer portions 202 reside therein. (Gonzalez, col. 3, ll. 29-37 and Figure 4.)
4. Gonzalez teaches outer portions 202 have two base tabs 214 each (see Figure 3) that extend below. Each base tab 214 is designed such that the second brackets 108' slides into an opening 220 of the first bracket

- 108 and stops sliding when the end of tab 214 reaches the end of opening 220. The brackets now being secured together, Gonzalez calls this “stacking” the brackets. (Gonzalez, col. 3, ll. 21-27.)
5. Gonzalez teaches stacking the brackets is a significant feature. The support wall 206 of the second bracket 108’ is adjacent and planar to the support wall 206 of the first bracket 108. Likewise, the support wall 207 of the second bracket 108’ is adjacent to and planar to the support wall 207 of the first bracket. (Gonzalez, col. 5, ll. 49-53.) As such, the brackets 108 and 108’ are in a vertical alignment with each other.
6. Ho teaches a disk drive bracket system for installing two disk drives in a computer without additional fastening hardware. (Ho, col. 1, ll. 21-28.) The lower diskdrive holder 2 is shaped like a channel plate and includes a plurality of hooks (tabs) 21, 22 on its top side. Tabs 21 are adapted to be secured to hook holes (slots) 16. (Gonzalez, col. 2, ll. 8-12.) As shown in Figure 1, slot 16 tapers toward the rear of the upper diskdrive holder 1.
7. Francovich teaches a housing having a square frontal cross-section. This cross-section permits either vertical or horizontal orientation of a disk drive and its control panel. (Francovich, col. 7, ll. 3-12.)
8. Yoshida teaches a detachable electronic apparatus with a handle 1 and catch lever 3 that are rotatably fixed in order to place the electronic apparatus in a secured or unsecured state. (Yoshida, col. 3, ll. 24-50.)

PRINCIPLES OF LAW

“The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’ *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). Care must be taken not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”)

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of

underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

“In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” 127 S.Ct. at 1739, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test. As such, The Supreme Court has addressed this overly rigid and formalistic application of the teaching-suggestion-motivation (TSM) test and rejected it. *Id.*

Instead, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor,
design incentives and other market forces can
prompt variations of it, either in the same field or a

different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

It is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (*see In re Royka*, 490 F.2d 981, 984-85 (CCPA 1974)) and that all words in a claim must be considered in judging the patentability of that claim against the prior art (*In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)).

With this as background, we analyze the specific rejections made by the Examiner of the claims on appeal.

ANALYSIS

The Appellants argue claims 1-11 and 15-20 as a group for the ground of rejection under the judicially created doctrine of obviousness-type double patenting. As such, we select claim 1 as the representative claim. As such, claims 2-11 and 15-20 will stand or fall with representative claim 1. The

Appellants argue claims 1, 3, 4, 6, 8, 10, 15, 19, and 20 as a group for the ground of rejection under 35 U.S.C. § 103(a) with Gonzalez and Ho. As such, we select claim 1 as the representative claim. As such, claims 3, 4, 6, 8, 10, 15, 19, and 20 will stand or fall with representative claim 1. The Appellants argue claim 9 separately for the ground of rejection under 35 U.S.C. § 103(a) with Gonzalez, Ho, and Francovich. The Appellants argue claims 12-14 as a group for the ground of rejection under 35 U.S.C. § 103(a) with Gonzalez and Yoshida. As such, we select claim 12 as the representative claim. As such, claims 13 and 14 stand or fall with representative claim 12.

In reaching our decision in this appeal, we have given careful consideration to the Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by the Appellants and the Examiner.

Non-statutory obviousness-type double patenting rejection of certain claims

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the Examiner is sufficient to establish claims 1-11 and 15-20 should be rejected under the judicially created doctrine of obviousness-type double patenting. In response to the Examiner's rejection on the ground of non-statutory obviousness-type double patenting, the Appellants "propose[] filing a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) if the Appellee's rejection properly stands after the outcome of the pending appeal." (App. Br. 4.) It is our determination that

the Examiner's rejection of the claims under the judicially created doctrine of obviousness-type double patenting, unargued as it is by the Appellants, is summarily sustained.

The obviousness rejections of claims 1, 3, 4, 6, 8, 10, 12-15, 19, and 20

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the Examiner is sufficient to establish a prima facie case of obviousness with respect to claims 1, 3, 4, 6, 8, 10, 12-15, 19, and 20. Accordingly, we will affirm the Examiner's decision to reject these claims under 35 U.S.C. § 103(a). With the claims properly interpreted we do not see where the Appellants have shown the Examiner erred in rejecting representative claims 1 and 12. However, we see where the Appellants have shown the Examiner erred in rejecting claim 9. Accordingly, we will not affirm the Examiner's decision to reject claim 9 under 35 U.S.C. § 103(a).

Obviousness rejection of claims 1, 3, 4, 6, 8, 10, 15, 19, and 20

We find Gonzalez teaches a bracket system having a plurality of chassis brackets to be attached to a chassis base. (Finding of Facts 1 and 2.) In addition, we find Gonzalez teaches a mounting bracket have a slot. (Finding of Fact 3.) Further, we find Gonzalez teaches a tab on the chassis base that is used to engage the slot on the chassis bracket. (Finding of Fact 3.) The Examiner found Gonzalez lacks teaching the slot being tapered, having a plurality of them, and the base likewise having a plurality of tabs. (Answer 5.) However, in an analogous bracket system, Ho teaches the slots

being tapered, a plurality of them, and likewise a plurality of tabs to be secured to the slots. (Finding of Fact 6.)

As such, we find all of the claimed limitations are taught within the combination of Gonzalez and Ho. Each element within the combination operates in accordance with its known function. In particular, Gonzalez teaches the slot and tab has a secure fit. As the Examiner pointed out in the Answer on page 5 to provide a tapered slot from the teaching of Ho where the entrance is wider then the stop point would provide convenience for engaging the tabs into the slots prior to securement. We agree with the Examiner. Having a wider slot entrance on the bracket would facilitate engagement of the tab on the chassis base before the bracket and chassis are secured. As such, we fail to find an unpredictable result from this combination of elements.

Obviousness rejection of claims 9

We find the Appellants have identified an error with the Examiner's rejection of claim 9. The Appellants contend Francovich teaches a housing supporting one device. (App. Br. 8.) We agree with the Appellants, see Finding of Fact 7.

Obviousness rejection of claims 12

The Appellants contend that Gonzalez lacks teaching a means for vertical alignment. (App. Br. 9.) We respectfully disagree. Gonzalez teaches the support walls of each bracket are adjacent and planar to one

another. (Finding of Fact 4 and 5.) As such, the brackets are in alignment vertically. Thus, this structure is a means for vertical alignment.

Lack of motivation to combine the references

The Appellants have argued through the Brief that there is a lack of motivation to combine the references. However, the Examiner did find motivation to combine the references; namely, to provide convenience for accessing the tabs into the slots and for releasing the subassembly from the chassis. (Answer 5 and 7.) With respect to the former, we understand the Examiner's statement to mean having a wider slot entrance on the bracket would facilitate engagement of the tab on the chassis base before the bracket and chassis are secured. With respect to the latter, we understand the Examiner's statement to having a handle mechanism would assist in the releasing the subassembly from the chassis and what the Appellants appear to actually contend is that the references cannot be properly combined because Yoshida's handle would interfere with the locking mechanism of Gonzalez. (App. Br. 8-9.) However, the issue is not whether the features of the secondary reference (Yoshida) may be bodily incorporated into the structure of the primary reference (Gonzalez) as the Appellants appear to be contending; but, whether what the combination of references would have suggested to those skilled in the art. *See In re Keller*, 642 F.2d 413 (CCPA 1981). In this case, the Examiner has found the combination of references (Gonzalez and Yoshida) would have suggested to one of skill in the art to provide a handle mechanism to a bracket system in order to assist in

releasing the subassembly from the chassis. We find that the Examiner's articulation of an apparent reason one having ordinary skill in the art would have combined the teachings of the prior art in the manner claimed is reasonable, and the Appellants have not persuaded us of any error in the Examiner's reasoning. *See KSR*, 127 S.Ct. at 1740-41

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Further, we find nothing in any of the references (Gonzalez, Ho, and Yoshida) that would discourage a person of ordinary skill in the art from providing either tapered slots to assist in engagement of the tab on the chassis base before the bracket and chassis are secured or to have a handle mechanism to assist in the releasing the subassembly from the chassis.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1-11 and 15-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Dean.

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1, 3, 4, 6, 8, 10, 15, 19, and 20 as unpatentable over Gonzalez and Ho.

We conclude the Appellants have shown that the Examiner erred in rejecting claim 9 as unpatentable over Gonzalez, Ho, and Francovich.

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 12-14 as unpatentable over Gonzalez and Yoshida.

DECISION

The decision of the Examiner to reject claims 1-11 and 15-20 under the judicially created doctrine of obviousness-type double patenting is affirmed.

The decision of the Examiner to reject claims 1, 3, 4, 6, 8, 10, 15, 19, and 20 as obvious is affirmed.

The decision of the Examiner to reject claim 9 as obvious is not affirmed.

The decision of the Examiner to reject claims 12-14 as obvious is affirmed.

No time period for taking any subsequent action in connection with this appeal may extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

JRG

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